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NOV 08 2005

In re Application of:

WHITTED *et al.*

Serial No.: 09/299,522

Filed: April 26, 1999

Attorney Docket No.: MSFT-3942/116646.01

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a response to the petition filed on May 24, 2004 under 37 C.F.R. § 1.181, to withdraw the holding of abandonment of the above-identified application. No fee is required.

The petition is **GRANTED**.

This application became abandoned for failure to timely respond to the final Office action mailed on June 3, 2003.

The petitioner asserts that a timely response was mailed to the United States Patent & Trademark Office (USPTO) on December 3, 2003. To support this assertion, petitioner has provided a copy of the response to the final Office action bearing a certificate under 37 CFR § 1.8(a) showing a date of mailing of December 3, 2003, a copy of the Terminal Disclaimer, a Petition for a Three-Month Extension of Time and authorization to charge fees to Deposit Account No. 500241.

A review of the application file record reveals that the above-identified response is not of record in the application file and cannot be located. However, 37 CFR § 1.8(b) provides for accepting a correspondence as being timely filed if it was mailed in accordance with 37 CFR § 1.8(a), and is reproduced below:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence: (1) informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware

that the Office has no evidence of receipt of the correspondence; (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and (3) includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition, meets the conditions of 37 CFR § 1.8(b) to establish the previous timely filing of the response.

Consideration of proposed after final amendments are addressed in 37 CFR § 1.113, 37 CFR § 1.116, and MPEP § 714.13 reproduced, in part, below:

37 CFR § 1.113 (c) states, in part, the following:

“(c) reply to a final rejection or action must include cancellation of or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.”

37 CFR § 1.116 (b) and (c) state, in part, the following:

“(b) ... amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, an amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment...”

“(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.”

Section 714.13 of the MPEP states, in part, the following:

“An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.”

* * *

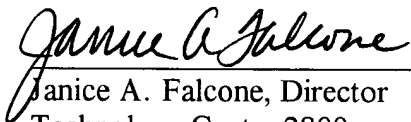
“It should be noted that under 37 CFR § 1.181(f), the filing of a 37 CFR § 1.181 petition will not stay the period for reply to an examiner’s action which may be running against an application. See MPEP § 1207 for appeal and post-appeal procedure.”

Under current practice, the proposed after final amendment would be entered if it *prima facie* placed the application in condition for allowance. The examiner, after consideration, has determined that the response to the final Office action would *prima facie* place the application in condition for allowance.

In view of the above stated reasons, the petition to withdraw the holding of abandonment for the above-identified application is granted.

The application file is being forwarded to the technical support staff for processing the response to the final Office action, the Terminal Disclaimer, and the Petition for Three-Months Extension of Time. From there, it will be returned to the examiner for further prosecution.

Inquiries regarding this decision should be directed to Jose’ G. Dees at (571) 272-1569.



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